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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/729,231	12/05/2003	Roger Thomas	P-US-PR 1107	9218

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EXAMINER

SELF, SHELLEY M

ART UNIT PAPER NUMBER

3725

DATE MAILED: 11/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/729,231

Applicant(s)

THOMAS, ROGER

Examiner

Shelley Self

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6,8,10,12 and 14-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6,8,10,12 and 14-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 4, 2006 has been entered.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-, 8, 12, 14, 15 and 17 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-14 of U.S. Patent No. 7,108,028

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(Serial No. 10/729, 204). Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the presently presented application are merely a broader version of the claims of the patent. Accordingly the narrow claims of the patent serve as a prima facie case of obviousness over that of the presently presented application. Furthermore, Examiner notes the claims of the presently presented application and that of the patent encompass the same subject matter and a similar scope. Accordingly the claims of the presently presented application are not patentably distinct over those of the patent and a Obvious Double Patenting Rejection is made.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 1-6, 8, 9, 10, 12 and 14-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With regard to claims 1 and 17, the recitation, "...the first rigid section includes a front portion and rear portion that define a lip...", it is not clear if it is the front or the rear portion that define a lip or if both portions define a lip. Examiner further notes that any structure has a front and rear portion. Clarification is required.

Claim Rejections - 35 USC § 103

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6, 8, 10 and 14-16 as best as can be understood are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang (6,712,106) in view of Schneider (6,520,365) as noted in previous Office Action. With regard to claims 1, 2, 4-6, 8, 10 and 14, Wang discloses a debris collection container for a planer (fig. 2) which employs a stream of air to remove debris generated by the planer (4), the debris collection container comprising: a receptacle for storage of the debris (5); and a connector (fig. 4) having a lip (i.e. a rim) connectable between the receptacle (5) having a first rigid section (50) and the planer (fig. 2) defining a path for debris passing from the planer to the receptacle and releasably attachable to the receptacle for sealing the aperture. Wang does not disclose the receptacle having a second rigid section with a deformable section located between and connecting the first rigid section and the second rigid section, or the first rigid section can be releasably attached to the second rigid section when the deformable section is in a compressed condition. Schneider teaches a specific type of receptacle for storage of debris. Schneider teaches a receptacle (fig. 1) having a first rigid section (14), a second rigid section (16, 28) that define a lip and a deformable section (12, 18) of transparent material located between and connecting the first rigid section and the second rigid section (figs. 1, 2), the deformable section (12, 18) includes a helical spring (20) and is manipulatable between a compressed condition and an expended condition (figs. 1, 2); wherein the first rigid section (14) defines an aperture and can be releasably attached to the second rigid section (16, 28) when

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the deformable section is in a compressed condition (fig. 2) and wherein the first rigid section is adjacent to the second rigid section. Schneider teaches this construction of a storage/debris receptacle so as to allow efficient storage of the receptacle when not in use. Because both Wang and Schneider teach debris/storage receptacles, it would have been obvious at the time of the invention to replace Wang's receptacle (5) with a collapsible receptacle (i.e. first and second rigid sections) so as to facilitate compact and efficient storage of the receptacle when not in use as taught by Schneider.

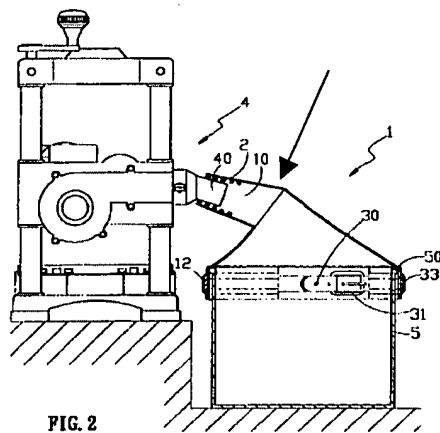
As to the loop, (clm. 3), Schneider discloses a loop and catch (64, 66) included on the first and second sections (14, 16) for releasably attaching the first section (14) to the second section (16, 28).

As to the transparent window (clm. 14), Examiner notes that Schneider teaches the use of various materials for the connector (col. 3, lines 11-27), one such material being any synthetic or man-made flexible material. Examiner notes, many transparent materials to be synthetic materials, such as polypropylene. Because Applicant has not stated a specific type of transparent material, Examiner notes Schneider to teach construction using transparent material.

With regard to claim 15 and 16, as best as can be understood, Wang discloses a part spherical shaped section (10; fig. 2) that curves the path of the debris as it passes through the part spherical section.

As to the 90 degrees (clm. 16) Examiner notes that the spherical section (10) curves the path of the debris and that some of the debris will follow the spherical section (10) to a highest most point and fall by air and gravity force downward, i.e., at a 90 degrees (fig. 2).

Wang (6,712,106) disclose, Air and gravitational force from the top of the dome section curve the debris substantially, 90°



Claim 17 as best as can be understood is rejected under 35 U.S.C. 103(a) as being unpatentable over Wang (6,712,106) in view of Liao et al. (6,481,475) and Schneider (6,520,365). As noted above with reference to claim 1, Wang discloses, a planer having a planer body (fig. 2), receptacle (5), cap (fig. 4), connector having a lip and conduit for removal of debris. Wang does not disclose a cutting drum rotatably mounted in the planer body, however it is obvious that the planer apparatus has a means for cutting so as to planarizer a work piece. Liao teaches in a similar art, a planer (fig. 2) having a planer body, debris exhaust conduit (43) and rotatable cutting member (35) mounted within the planer body.

Schneider teaches as noted above a receptacle having a first and second rigid section and deformable section there between.

Because both Wang and Liao are from a similar art and deal with a similar problem (i.e., collecting/storing debris from a planer apparatus/device) it would have been obvious at the time of the invention to one having ordinary skill in the art to replace Wang's means for cutting with a rotatable cutting member as taught by Liao so as to efficiently planarizer a work surface.

Further, it would have been obvious for the reasons set forth with regard to claim 1 to replace, Wang's receptacle with a collapsible receptacle (i.e., first and second rigid sections and

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deformable section there between) as taught by Schneider so as to efficiently store the receptacle when not in use.

Allowable Subject Matter

Claim 12 appears to contain allowable subject matter and is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and if the Double Patenting rejection(s) were overcome.

The following is a statement of reasons for the indication of allowable subject matter: The prior art of record does not disclose or fairly suggest a debris collection container for a planer comprising a means for connecting comprising a first part including two pegs and a second part having a T-shaped slot, wherein one of the first part and the second part is mounted on the receptacle and the other of the first part and the second part is mounted on the cap in combination with the rest of the claimed limitations as set forth in claim 12.

The prior art reference, Wang discloses a connector (80) having rails, connection plates (81) and grooves (801) such that the plates (81) are positionable within the grooves (801) of the rails (80) so as to connect the cap/connector (fig. 4) to the receptacle (5). Further, Wang discloses that the cap/connector (fig. 4) is connected to the receptacle by the fastening member (31, 33, 300) Wang does not disclose or fairly suggest first and second parts having pegs and T-shaped slots wherein a one of the first and second parts is mounted on the receptacle and the other of the first and second parts is mounted on the cap. Instead, Wang discloses that the means for connecting the cap to the receptacle is mounted on the cap (fig. 4) with a flange (50) on the

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receptacle to correlate with the rails (80) and fastening means (33). Accordingly, Wang fails to anticipate or render obvious the claimed invention as set forth in claim 12.

Neither the prior art of record nor any combination thereof discloses the claimed invention as set forth in claim 12. Therefore claim 12 contains allowable subject matter over the prior art of record and would be deemed allowable if re-written to encompass all of the subject matter of the parent claim(s) and if the Double Patenting Rejection(s) were overcome.

Response to Arguments

Applicant's arguments filed October 4, 2006 have been carefully considered but they are not persuasive. Applicant's remarks are drawn to the failure of the prior art Schneider to disclose *a front and rear portion that define a lip*. However this is not found persuasive, because as noted above any mechanical structure has a front and rear portion and such portions to be relative depending upon an initial starting portion/location. As to the argument that Schneider does not define a lip, Examiner notes the rim, uppermost portion of Schneider's top (14) to be a lip, similarly the rim/flange (50) of Wang can be defined as a lip. Accordingly Schneider does disclose the claimed invention, accordingly a rejection in view of Schneider is made.

As to Applicant's remarks, a first rigid section that includes *a front portion and a rear portion that define a lip and the connector is releasably attachable to the front portion*, Examiner notes an inner portion (i.e., inner diameter) of the connector to be a front portion and the outer surface (i.e. outer diameter) of the connector (fig; 1, 2; Wang) to be a rear portion thus the connector is releasably attached to the front portion (fig. 1; Wang). Accordingly the rejection of Wang in view of Schneider stands.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shelley Self whose telephone number is 571-272-4524. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 571-272-4419. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SSelf

November 11, 2006